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NOTICE OF ALLOWANCE AND FEE(S) DUE

22862

7590

03/19/2009

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2435

DATE MAILED: 03/19/2009

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,290

11/19/2003

Jeff Hooker

AO10153

1210

TITLE OF INVENTION: METHOD AND APPARATUS FOR SECURE INSTANT MESSAGING UTILIZING SERVER-SUPERVISED PUBLICATION

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	06/19/2009

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE** OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** **Mail Stop ISSUE FEE**
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

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Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

22862 7590 03/19/2009
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MENLO PARK, CA 94025

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,290 11/19/2003 Jeff Hooker AOL153 1210

TITLE OF INVENTION: METHOD AND APPARATUS FOR SECURE INSTANT MESSAGING UTILIZING SERVER-SUPERVISED PUBLICATION

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	06/19/2009

EXAMINER	ART UNIT	CLASS-SUBCLASS
SHAN, APRIL YING	2435	713-176000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY AND STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____
Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,290	11/19/2003	Jeff Hooker	AOL0153	1210
22862	7590	03/19/2009	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			SHAN, APRIL YING	
			ART UNIT	PAPER NUMBER
			2435	

DATE MAILED: 03/19/2009

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 866 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 866 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Notice of Allowability**Application No.**

10/718,290

Applicant(s)

HOOKER ET AL.

Examiner

APRIL Y. SHAN

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3 December 2008.
2. ☒ The allowed claim(s) is/are 7-9,11-25 and 27-31.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. The Applicant's amendment, filed 03 December 2008, has been received and entered into the record, respectfully and carefully considered.
2. As a result of the amendment, claims 7 and 23 are amended. Claims 10 and 26 are canceled. No new claims have been added. Claims 1-6 and 32-38 are withdrawn from consideration since they are non-elected claims in response to restriction/election requirement. Therefore, claims 1-9, 11-25 and 27-38 are pending in the application. Claims 7-9, 11-25 and 27-31 have been examined.

Claim Rejections - 35 USC § 101

3. As a result of the amendments and authorized examiner's amendment to the specification, the examiner withdraws the pending 35 USC § 101 rejection.

The examiner notes in the amendment to the specification submitted 03 December 2008, in which the Applicant **deletes** signal bearing, signal bearing medium, signals and electromagnetic waves from paragraphs [1027] and [1065] of the original disclosure. Further, in the below authorized examiner's amendment, additional signal bearing, signal bearing medium, signals and electromagnetic waves are **removed** from the original disclosure and paper punch cards" is also **deleted** from paragraph [1027] of the original disclosure. Thus, the examiner takes the act of deleting as a disavowal. Furthermore, in paragraph [1027] of the instant specification, the Applicant discloses "storage diskette...hard drive...ROM, EPROM, flash PROM ". It is clear that to an ordinary skill in the art storage diskette, hard drive, ROM, EPROM, are flash PROM are

all computer readable data storage medium. Thus, claims 23-25 and 27-31 are statutory.

Also, in the method claims 7-9 and 11-22, a messaging server is being recited and according to par. [1020] of the original disclosure, the server comprises a digital data processing apparatus such as one or more personal computers, computer workstations and etc. Thus, at least one hardware-software combination machine is being recited and the claims are positively tied to a particular machine that accomplishes the claimed method steps. Therefore, claims 7-9 and 11-22 are statutory.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Ms. Elizabeth Ruzich (Registration No. 54,416) on 9 March 2009 and 13 March 2009. The amendment is to cancel non-elected claims and to further clarify the invention. As per MPEP 713.04, a separate interview summary form is not provided because the content of the interview has been summarized herein.

The application has been amended as follows:

➤ **IN THE SPECIFICATION:**

- Please **remove** "signal bearing medium," from page 3, paragraph [1006], line 5.

- Please **replace** "signal-bearing medium" on page 4, paragraph [1009], line 1 with "magnetic data storage diskette." Support for this amendment can be found, for example, on page 9, paragraph [1027], line 6.
- Please **remove** ", and signal bearing medium" from the last line of paragraph [1013], which spans pages 4-5.
- Please **remove** "Signal-Bearing Media" from the heading before paragraph [1027] on page 9.
- Please **replace** paragraph [1027], which starts on page 9, line 1 and ends on page 10, line 2 with the following marked-up version:

Wherever the functionality of any operational components of the disclosure is implemented using one or more machine-executed program sequences, these sequences may be embodied in various forms of signal-bearing computer readable data storage media. In the context of FIGURE 2, such a signal-bearing computer readable data storage media may comprise, for example, the storage 204 or another signal-bearing computer readable data storage media, such as a magnetic data storage diskette 300 (FIGURE 3), directly or indirectly accessible by a processor 202. Whether contained in the storage 206, diskette 300, or elsewhere, the instructions may be stored on a variety of machine-readable data storage media. Some examples include direct access storage (e.g., a conventional "hard drive", redundant array of inexpensive disks ("RAID"), or another direct access storage device ("DASD")), serial-access storage such as magnetic or optical tape, electronic non-volatile memory (e.g., ROM, EPROM, flash PROM, or EEPROM), battery backup RAM, optical storage

(e.g., CD-ROM, WORM, DVD, digital optical tape), ~~paper "punch" cards~~, or other suitable ~~signal-bearing~~ computer readable data storage media including analog or digital transmission media and analog and communication links and wireless communications. In one embodiment, the machine-readable instructions may comprise software object code, compiled from a language such as assembly language, C, etc.

- Please **replace** "signal-bearing" in paragraph [1028], line 1 on page 10 with "computer readable data storage"
- Please **remove** "and signals" from paragraph [1065], line 2 on page 22.
- Please **remove** "signals" from paragraph [1065], line 4 on page 22.
- Please **remove** "electromagnetic waves," from paragraph [1065], line 5 on page 22.

IN THE CLAIMS:

- Please **cancel Claims 1-6 and 32-38**
- Please **replace claims 7 and 23** as below:

(Claim 7) (Currently Amended) A method of managing ~~the~~ exchange of secure online instant messages between subscriber devices, where the secure messages are signed and encrypted using subscribers' digital certificates, the method comprising ~~the~~ steps of:
a messaging server receiving a log-in request from at least one subscriber device comprising a local instant messaging module to begin a session of exchanging synchronous online messages;

the local instant messaging module submitting a certificate publication request to the messaging server, the publication request also specifying a digital certificate corresponding to the subscriber device;

the messaging server receiving a the certificate publication request from said local instant messaging module, ~~the publication request also specifying a digital certificate corresponding to the subscriber device;~~

responsive to each the certificate publication request, the messaging server temporarily storing the ~~submitted~~ digital certificate in a publication record in association with the ~~submitting subscriber~~ device as long as the associated instant messaging module remains logged-in to the messaging server;

responsive to prescribed events, the messaging server providing logged-in subscriber devices with selected information concerning certificates of other subscriber devices;

responsive to a particular subscriber device ending the session, the messaging server automatically removing the ~~submitted~~ digital certificate from the publication record for the particular subscriber device;

receiving a particular subscriber device's request to un-publish ~~it's~~ the digital certificate; and in responsive to receiving the request to un-publish the digital certificate, the messaging server removing the digital certificate from the publication record for the particular subscriber device[[.]];

identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging[[.]]; and

notifying the identified other logged-in subscriber devices ~~of that~~ the digital certificate for the particular subscriber device is withdrawn from use.

(Claim 23) (Currently Amended) A messaging server for use in managing the an exchange of secure online instant messages between subscriber devices, where ~~the~~ secure messages are signed and encrypted using subscribers' digital certificates, ~~the a~~ messaging server comprising:

a computer-readable data storage medium; and

at least one digital data processor coupled to the computer-readable data storage medium[[:]], the data processor programmed to perform operations comprising:

beginning a session of exchanging synchronous online messages by receiving log-in from a local instant messaging module[[s]] associated with a ~~of one or more~~ subscriber device[[s]];

receiving from ~~one or more of~~ the logged-in device[[s]] s associated local instant messaging module[[s]] a certificate publication request specifying a digital certificate corresponding to ~~the~~ a particular subscriber device;

responsive to each the certificate publication request, temporarily storing the ~~submitted~~ digital certificate in a publication record in association with the ~~submitting~~ particular subscriber device as long as the associated instant messaging module remains logged-in to the messaging server;

responsive to prescribed events, providing other logged-in subscriber devices with selected information concerning the digital certificate ~~for the particular subscriber devices of other subscriber devices~~;

~~receiving a certificate publication request from said local instant messaging module;~~

responsive to a particular subscriber device ending the session, the messaging server automatically removing the digital certificate from the publication record for the particular subscriber device;

~~receiving a particular subscriber device's request to un-publish its digital certificate; and~~

receiving a particular subscriber device's request to un-publish ~~it's~~ the digital certificate; and in responsive to receiving the request to un-publish the digital certificate, the messaging server removing the digital certificate from the publication record for the particular subscriber device[[,]];

identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging[.]; and

notifying the identified other logged-in subscriber devices of that the digital certificate for the particular subscriber device is withdrawn from use.

Response to Arguments

5. Applicant's argument filed 3 December 2008 have been fully considered and they are persuasive (See allowable subject matter below)

Allowable Subject Matter

6. Claims 7-9, 11-25 and 27-31 are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2435
**/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435**